UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,020	02/12/2002	Bryan L. Ackerman	J 2961A	8089

28165 7590 10/08/2003

S.C. JOHNSON & SON, INC.
1525 HOWE STREET
RACINE, WI 53403-2236

EXAMINER	
CHEVALIER, ALICIA ANN	

ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/075,020	Applicant(s) ACKERMAN ET AL.
	Examiner Alicia Chevalier	Art Unit 1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *08 January 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-69* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-69* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 6, 8, 9, 10, 11, 13
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Examiner's Comment

1. Regarding the term "cut-resistant", the specification on page 3, lines 26-29 recites, "a processing substrate includes a sheet having a surface capable of withstanding cutting by a serrated knife without substantial compromise of the sheet …". The specification on page 6, lines 18-23 further recites, "the sheet also includes a cut-resistant, liquid-permeable top or upper portion or layer, which substantially prevents the integrity of the sheet as a whole from being compromised during cutting … the upper portion or layer is made of a material sufficiently durable to withstand aggressive cutting …". Page 26 of the specification discloses several different materials used as the cut-resistant layer including paper. While the term "cut-resistant" is not indefinite, Applicant's specification does not give a concise definition of the term. Applicant's use of the phrase "substantial compromise," "sufficiently durable", "substantially prevents" does not give the necessary information about the layer to determine what is considered to be acceptable compromise of the layer or how much damage the layer will suffer or not. Therefore, giving the term it's broadest reasonable interpretation (MPEP 2111) in light of the specification it is the Examiner's position that any layer with a tissue ply and a thermoplastic material ply is "cut-resistant" and substantially prevents the integrity of the sheet from being compromised during cutting.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5, 10-12, 14, 16, 25, 26, 30, 33-37, 42-44, 46, 48, 57, 61 are rejected under 35 U.S.C. 102(b) as being anticipated by Pawlowski et al. (4,935,282).

Pawlowski discloses an absorbent insert for food packages, a single use processing substrate. The package comprises a top cooking surface layer (first cut-resistant layer), an absorbent layer (tissue layers) and a bottom sheet (second layer) that may be attached to the underside of the absorbent layer (col. 4, lines 41-60 and figure 9). The top layer and the bottom sheet may comprise thermoplastic films (col. 3, lines 43-63). The absorbent layer is made of a cellulosic web (col. 3, lines 64-68) and may comprise two layer (1st and 2nd tissue layers) of absorbent materials depending on the specific absorbent requirements (col. 4, lines 26-40). As seen from figures 8 and 9 the first layer of tissue ply is disposed below the first layer and when using a second tissue layer it is disposed above the second layer. From figures 8 and 9 it can be seen that an unfolded second layer having a second surface area, wherein the first layer is secured to and substantially centered on the second layer in both dimensions/directions such that a portion of the second surface area is laterally disposed outside the first surface area.

The first thermoplastic layer and the first tissue layer are provided with substantially circular apertures (figure 9 and col. 4, lines 61-66). The apertures are regularly in a zig-zag

pattern (see the figures). All of the layers may be attached together by any suitable means such as adhesive (col. 4, lines 41-56).

The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitations "the first layer thermoplastic material ply is extrusion coated onto the first tissue ply" – claims 3 and 35, "wherein the second layer thermoplastic material ply is extrusion coated onto the second layer tissue play" – claims 5 and 37, "wherein the apertures are created by perforating" – claim 11, "where in the apertures are created by punching" – claim 12 are a method of production and therefore does not determine the patentability of the product itself.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 6-9, 13, 15, 17, 18, 28, 29, 38-41, 45, 47, 49, 50, 59, 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pawlowski et al. (4,935,282).

Pawlowski discloses all the limitations of the instant claimed invention except for thickness of each ply, aperture diameter and specific spacing/average per inch or the dimensions of the first and second layer.

However, Pawlowski further discloses that the required thickness of the absorbent layer depend on the amount and kind of fluid being absorbed (col. 4, lines 26-30).

The exact thickness first and second tissue plies is deemed to be a cause effective variable with regard to the absorbent properties of the layers. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as thickness of the tissue layers through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would be motivated to optimize the thickness of the absorbent layers depending upon the type of liquid that needs to be absorbed.

The exact thickness first and second thermoplastic material plies is deemed to be a cause effective variable with regard to the protective properties of the plies of the absorbent layers. It

would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as thickness of the thermoplastic material layers through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would be motivated to optimize the thickness of the thermoplastic layers in order to prevent the absorbent core from being damaged.

The exact aperture diameter and spacing/aperture per square inch is deemed to be a cause effective variable with regard to the fluid passage rate to the absorbent layers. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as thickness of the diameter and spacing of the apertures through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would be motivated to optimize the aperture diameter and space in order to optimize the fluid passage rate to the absorbent layer in order to avoid leakage.

The exact dimensions of the layers is deemed to be a cause effective variable with regard to the size of the item to be packaged. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as dimensions of the layers through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would be motivated to optimize the dimensions of the layers in order accommodate the size of the item to be packaged.

6. Claims 19-24 and 51-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pawlowski et al. (4,935,282) in view of Tanizaki et al (5,998,039).

Pawlowski discloses all the limitation of the invention except for the claimed resin composition of the first and second thermoplastic plies.

Tanizaki discloses a polypropylene composition employed particularly in the field of food packaging because of their excellent mechanical properties such as tensile strength, rigidity, surface hardness, impact resistance and cold temperature resistance, optical properties such as glossiness and transparency, and food hygienic properties such as nontoxicity and odorless properties (col. 1, lines 32-45). The polypropylene composition includes a resin comprising metallocene polypropylene (col. 5, lines 35-39) comprising a copolymer of propylene and ethylene (col. 6, lines 1-4). The resin further includes talc additive in an amount less than about 10 percent by weight of the resin (col. 29, lines 44-46), calcium, magnesium (col. 26, lines 35-48) and an antioxidant (col. 24, line 43 to col. 25, line 53).

It would have been obvious to use the polypropylene composition of Tanizaki as the thermoplastic material of the first and second thermoplastic layers in Pawlowski because of the excellent mechanical properties such as tensile strength, rigidity, surface hardness, impact resistance and cold temperature resistance, optical properties such as glossiness and transparency, and food hygienic properties such as nontoxicity and odorless properties of Tanizaki's composition.

7. Claims 27 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pawlowski et al. (4,935,282) in view of Phillips (5,414,248).

Pawlowski discloses all the limitation of the invention except for the first surface area and the portion of the second surface area laterally disposed outside of the first surface area are embossed.

Phillips discloses a grease and moisture absorbing insert for use in food containers (col. 2, line 63 to col. 3, line 7). The insert comprises a first layer with a plurality of holes, an absorbent layer and a bottom layer (figures 1 and 2). The layers can be bonded together using thermal embossing techniques to secure the absorbent layer while at the same time still allowing the apertures in the film provide good fluid penetration (col. 11, lines 18-25).

It would have been obvious to one of ordinary skill in the art at the time of the invention to thermal emboss as taught by Phillips the first surface area and the portion of the second surface area laterally disposed outside of the first surface area of Pawlowski because of the good bonding achieved will still maintaining good fluid penetration.

8. Claims 31, 32 and 62-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pawlowski et al. (4,935,282) in view of Komatsu et al. (4,657,133) and evidenced by Incorvia et al. (6,103,141).

Pawlowski discloses all the limitation of the invention except for the different claimed patterns of applying the adhesive and adhesive composition.

Komatsu discloses a food packaging material (col. 1, lines 11-22) in which the layers are adhesively bond together, wherein the adhesive is applied in a patter such as a grid pattern to assure gas permeability (col. 4, lines 16-19).

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the adhesive of Pawlowski in a grid pattern as taught by Komatsu because it would assure gad permeability as well as liquid permeability through the top layer to the absorbent core.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use ethyl vinyl acetate adhesive, since it have been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. As evidenced by Incorvia, which discloses ethyl vinyl acetate as typical adhesive used in food packaging materials (col. 1, lines16-20 and col. 4, lines 21-31).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Brown (5,151,314) discloses a similar substrate.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9306. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac
9/8/03